

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This preliminary amendment is in response to the Office Action mailed April 11, 2003 in regards to the parent application. Because the present Continuation maintains the claims as originally filed in the parent application, the following remarks are provided to address the concerns of the Examiner.

Claims 3, 4, 17-20 of the parent application were objected to. Claims 1, 2, 5-16, and 21-23 of the parent application were rejected. Claims 24 and 25 were allowed. Claims 24 and 25 have been cancelled by this amendment

Claims 1-25 were originally presented in the parent application. Claims 1-23 remain in the Continuation application. Claims 1, 7, 8, 14, 15, 16, 21, and 22 have been amended to correct typographical errors, and have not narrowed the scope of the claims, or added new material.

Referring to the prior Office Action dated April 11, 2003:

Claim Rejections - 35 U.S.C. § 112

Claims 8 and 9 stand rejected under § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, as to claim 8, "the sample" lacks antecedent basis. Claim 8 has been amended to establish an antecedent basis for "the sample", and Applicant submits that the rejection has been overcome.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 2, 5-7, 11-16, 21-23 including independent claims 1 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Statement in view of Debe et al. U.S. Patent Number 6,040,077.

In order to most succinctly explain why the claims presented herein are allowable, Applicant will direct the following remarks primarily to the originally presented independent

claims 1 and 15 with the understanding that once an independent claim is allowable, all claims depending therefrom are allowable.

The Applicant's invention was not obvious in view of Debe because Debe's patent is in a field of non-analogous art. Debe's field of endeavor was to provide nanostructured elements in the electrode of a membrane electrode assembly for use in fuel cells, and to provide catalysts in a fuel cell electrode. Nowhere does Debe's patent teach or suggest collecting zinc whiskers for the purpose of determining their possible detrimental effects on electronic devices stored in data centers. Instead, he is purposely making zinc whiskers as a part of the electrode of a membrane electrode assembly for use in fuel cells, and only collects the whiskers to find their bulk composition.

Conversely, the Applicant was involved in solving the problem of zinc whiskers forming in areas, such as the zinc electroplated floor tiles used in data centers, where electronic components might be susceptible to short circuits caused by the whiskers. Because Debe's invention was focused on providing catalysts in a fuel electrode, wherein making whiskers was a minor part, it cannot be said that Debe's invention was "reasonably pertinent to the particular problem with which the inventor was involved."

Furthermore, Debe does not anticipate the Applicant's independent claim 1, because Debe does not teach or suggest "providing a tool capable of capturing and retaining the whisker-like metallic particulates in their fragile condition" or "extracting from the surface any whisker-like metallic particulates present in substantially their fragile condition." Debe is unclear as to whether it would be important to maintain the whiskers in their fragile condition to determine their bulk composition. Debe is also unclear as to whether it is even possible to remove whiskers using a "dental adhesive" while maintaining the whiskers in their fragile condition. There are numerous types of dental adhesives, and the properties of the particular type of dental adhesive used by Debe remain indefinite. Because many types of dental adhesives have a fairly rapid cure-time, it is highly possible that the drying of the dental adhesive would not retain the whiskers in their fragile state.

Conversely, the Applicant stresses the importance of retaining the whiskers in their fragile condition. As modern electronic components have become increasingly smaller, it has

become important that sampled whiskers are maintained in their fragile state in order to determine whether they pose a threat to the electronic components. Because the exact intent and possibilities of Debe's method of removing whiskers are unknown, it cannot be said, as the examiner suggests, that Debe's method of removing whiskers would "certainly" retain the whiskers in their fragile condition.

Finally, Debe does not anticipate the Applicant's claim 1, because Debe does not teach or suggest "locating a surface of the data center where (whisker-like) metallic particulates may be present." The Applicant is interested in solving the particular problem of determining the existence of metallic particulates in a data center, where certain types of whisker-like metallic particulates may pose a threat to electronic components. Conversely, Debe removes whiskers from "the substrate", referring to the substrate whereon the nanostructured elements are deposited. Because the whiskers Debe removes from "the substrate" were purposely made, it is apparent that Debe is not concerned with locating a surface of a data center where metallic particulates *may* have formed in a *nonpurposeful* manner.

In light of the above arguments, Applicant respectfully submits that the examiner has not established a Prima Facie case that one skilled in the art would be motivated to modify Debe to reach the Applicant's invention. Because Claims 2, 5, 6, 7, 11, 12, 13, and 14 are dependent on claim 1, it has accordingly been demonstrated that claims 2, 5, 6, 7, 11, 12, 13, and 14 are not obvious in light of the art of record. In particular, claim 2 is one embodiment of the tool used to capture and retain the whisker-like metallic particulates in their fragile condition. Claim 5, claims that one embodiment of extracting is by "pressing the adhesive portion on the surface." Debe never specifically mentions this embodiment. Finally, Debe never teaches or suggests removing whiskers from a floor tile, as claimed in claim 13, or the bottom of the floor tile, as claimed in claim 14.

For many of the same reasons stated above, Debe does not anticipate Applicant's independent claim 15. Additionally, the Applicant discloses a method for *discovering* a presence of an *undesired* whisker-like metallic particulate in a data center. Because Debe is purposefully making whiskers, it cannot be said that Debe's whiskers are undesired. Finally, to discover a whisker, it must be unknown as to whether the whisker exists. Because Debe's invention

involves the purposeful making of whiskers, their existence would be known, and his disclosure would not aid in the discovery of unknown whiskers.

Claims 16, 21 and 22 are dependent on claim 15. Accordingly, it has been demonstrated that claims 16, 21, and 22 are not obvious in light of the art of record.

In light of the above arguments, Applicant respectfully submits that claim 1, 2, 5-7, 11-16, and 21-23 are allowable, and urges the Examiner to withdraw the rejection.

Dependent claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Statement in view of Debe et al. U.S. Patent Number 6,040,077, and further in view of Moos U.S. Patent Number 3,074,276.

The Debe and Moos references, when combined, do not teach or suggest all of the elements of claim 10, considering that claim 10 is dependent on claim 1. Specifically, as argued above, the Debe reference does not teach all of the elements of Applicant's claim 1, and the Moos reference does not overcome that deficiency. Moos teaches a technique for preparation of samples for both bacteria and radioactivity, but does not teach a technique for sampling for a presence of fragile whisker-like metallic particulates in a data center. Because claim 10 is dependent on claim 1, and because Debe and Moos do not collectively teach claim 1, Applicant respectfully submits that claim 10 is allowable.

Dependent claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Statement in view of Debe et al. U.S. Patent Number 6,040,077, and further in view of Jezek U.S. Patent Number 6,021,681.

The Debe and Jezek references, when combined, do not teach or suggest all of the elements of claims 8 and 9, considering that claims 8 and 9 are dependent on claim 1. Specifically, as argued above, the Debe reference does not teach all of the elements of Applicant's claim 1, and the Jezek reference does not overcome that deficiency. Jezek teaches a device for sampling radioactive waste, but does not teach a technique for sampling for a presence of fragile whisker-like metallic particulates in a data center. Because claims 8 and 9 are dependent on claim 1, and claim 1 is not collectively taught by Debe and Jezek, Applicant respectfully submits that claims 8 and 9 are allowable.

Furthermore, there is no motivation to combine the Debe reference with either the Moos reference or the Jezek reference. The references teach away from each other because Debe teaches of providing catalysts in a fuel cell electrode, while Jezek and Moos teach of devices for sampling radioactive waste.

Dependent claims 3, 4, and 17-20 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Because claims 3 and 4 are dependent on claim 1, and claims 17-20 are dependent on claim 15, and because Applicant believes independent claims 1 and 15 to be allowable, Applicant respectfully submits that claims 3, 4, and 17-20 are also allowable.


CONCLUSION

In light of the above, Applicant respectfully submits that pending claims 1-23 are in condition for allowance. Therefore, Applicant requests that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call Vaughn North at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 20-0100.

DATED this 8 day of Sept, 2003.

Respectfully submitted,



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